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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/037,977	11/09/2001	David A. Nicholas	1273 CIP CON FWC CON III	1065
7590	04/05/2005		EXAMINER	WEBB, SARAH K
United States Surgical, a division of TYCO HEALTHCARE GROUP LP 150 Glover Avenue Norwalk, CT 06856			ART UNIT	PAPER NUMBER
			3731	

DATE MAILED: 04/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

SP

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/037,977	NICHOLAS ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Sarah K Webb	3731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM  
 THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 11 March 2005.

2a) This action is FINAL.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 46-48 and 50-56 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 46-48 and 50-56 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_

**DETAILED ACTION**

***Terminal Disclaimer***

1. The terminal disclaimer filed on 3/11/05 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of US Patent 5,383,888 has been reviewed and is accepted. The terminal disclaimer has been recorded.

***Response to Arguments***

2. Applicant's arguments, see page 7, filed 3/11/05, with respect to the rejection(s) of claim(s) 46-48 and 51-56 under 112 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of US Patent No. 5,235,966 to Jamner.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 46-48, 50-53, 55 and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 4,880,015 (Nierman) in view of US Patent No. 5,235,966 to Jamner.

Nierman discloses an instrument that includes a handle portion (43,44), elongated tube (45), articulating portion (54 in Figure 7), tool head with two cooperating jaws (46), a link to pivot the articulation portion (56 in Figure 7), and an actuation member (47) to open and close the jaws. The actuation member is a flexible cable (column 7, line 63). The jaws can be described as "graspers." The handle portion (see Figure 11) includes a fixed handle (43) and a movable handle (42) that is

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connected to the link (56) by a "rod" (48) (column 8, lines 51-65). The articulating portion can pivot 90 degrees (column 8, lines 64). As shown clearly in Figure 7, the tubular shaft (45) includes a longitudinal slot (65) at the distal end for accommodating the articulating portion. In the background portion of the disclosure, Nierman teaches that it is well known in the art to include a "rotatable wing member" (22 in Figure 1) to effect rotation of the articulating portion (column 2, lines 34-36).

Nierman fails to form the tubular endoscopic portion (45) so that it rotates with respect to the handle portion. Jamner discloses a similar endoscopic device with a handle portion (3), movable jaws (19,20), and an elongate tube (1). Jamner teaches that a mechanism for rotating the elongate tubular portion (1) relative to the handle (3) should be included to provide optimum positioning with minimum instrument movement (column 3, lines 59-66). The mechanism is in the form of a rotating collar (31) secured to the proximal end of the shaft (1). It would have been obvious to one of ordinary skill in the art at the time the invention was made to form the tubular endoscopic portion of Nierman so that it rotates relative to the handle, as Jamner teaches that this allows the user to rotate the shaft and jaws without rotating the entire instrument.

4. Claim 54 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nierman in view of Jamner, as applied to claim 46 above, and further in view of US Patent No. 5,350,391 to Iacovelli.

Nierman fails to form the jaws as "multiple blade members." Iacovelli discloses a similar endoscopic device to Nierman and teaches that jaws can be in the form of scissors, tweezers, or forceps, which are all considered to meet the broad limitation "multiple blade members" (see Figures 13-16 and column 5, line 7). It would have

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been obvious to one of ordinary skill in the art to replace the jaws of Nierman with blade members, as taught by Iacovelli, as this is a simple modification to the device that merely alters the shape of the jaws.

**Conclusion**

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sarah K Webb whose telephone number is (571) 272-4706. The examiner can normally be reached on Mon-Fri 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan T. Nguyen can be reached on (571) 272-4963. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SKW  
3/30/05

SKW

*Julian W. Woo*

**JULIAN W. WOO  
PRIMARY EXAMINER**